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10/583,685	06/19/2006	Walter Held	2003P19344WOUS	4486
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K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER ULLAH MASUD, MOHAMMAD R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,685	Applicant(s) HELD, WALTER	
	Examiner MOHAMMAD R. ULLAH MASUD	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 03029454.0.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Status of the Claims

- Claims 1-18 were “cancelled”
- Claims 19-38 are “new” and currently pending in the application.

Information Disclosure Statement

The Information Disclosure Statement submitted by the applicant on June 19, 2006 was considered by the examiner.

Drawings

The drawings were received on June 19, 2006. These drawings are accepted by the Examiner.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

These claims contain subject matters which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. After a thorough review of the specification, Examiner has determined, applicant has not given sufficient guidance or

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direction to enable one skilled in the art to “billing device”, “service brokering device”, and “application server” to make or use the invention without undue experimentation. Applicant has not given sufficient reason what is meant by those terms. Since applicant has not provided any objective criteria as to what are those terms, each user's understanding would be different and therefor not consistent.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-20, 22-23, and 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The preamble of these recite a method, however the body of the claims do not positively tie the process steps to said apparatus.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 19-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (US 6,529,593), in view of Gonthier et al. (US 2002/0165783) (hereinafter referred to as Gonthier).

With respect to **claim 19**, Nelson discloses a method for using a billing device for charging for a service in a communication network (see, for example, column 3 lines 28-48), comprising:

requesting a confirmation of charge information by a client (see, for example, column 6 lines 53-57); and

registering charges if the billing device receives the confirmation from the client (see, for example, column 6 lines 53-57), but Nelson does not explicitly disclose a method comprising, receiving a service request from a service brokering device, generating a billing reference for a client with respect to the service request, and receiving a ticket issued by an application server, the ticket containing charge information relating to the service.

However, Gonthier discloses a method comprising:

receiving a service request from a service brokering device (see, for example, paragraph [0013]);

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generating a billing reference for a client with respect to the service request (see, for example, paragraph [0032] - [0044]);

receiving a ticket issued by an application server, the ticket containing charge information relating to the service (see, for example, paragraph [0056] - [0063]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to use a billing device for charging for a service in a communication network comprising, receiving a service request from a service brokering device, generating a billing reference for a client with respect to the service request, and receiving a ticket issued by an application server, the ticket containing charge information relating to the service, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claim 20**, Nelson discloses a method, further comprising sending the billing reference directly to the client (see, for example, column 6 lines 40-51).

With respect to **claim 21**, Nelson discloses a method, further comprising sending the billing reference indirectly to the client via the service brokering device (see, for example, column 6 lines 40-67).

With respect to **claim 22**, Nelson discloses a method, wherein the registration of the charges is carried out equally for a prepaid client and for a billed client (see, for example, column 7 lines 4-7 and 50-61).

With respect to **claim 23**, Nelson discloses a method, wherein the registration of charges consists in the ticket being stored so that a bill can be generated later (see, for example, column 3 lines 28-48).

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With respect to **claim 24**, Nelson discloses a method, wherein the registration of charges occurs in the device updating the client's level of credit or charges (see, for example, figure 3a, column 7 lines 16-40).

With respect to **claim 25**, Nelson discloses a method, further comprising:

informing the client if a credit level reaches or falls below a threshold (see, for example, figure 3a, column 7 lines 41- 50); and

informing the application server if there are insufficient funds for a prepaid user (see, for example, figure 3a, column 7 lines 4 - 15).

With respect to **claim 26**, Nelson discloses a method, further comprising informing the client of charges incurred for the registration of charges (see, for example, column 3 lines 49-56).

With respect to **claim 27**, Nelson discloses a method, wherein the billing device receives service requests from a plurality of service brokering devices (see, for example, column 3 lines 57-67).

With respect to **claim 28**, Nelson discloses a method for using an application server for charging for a service in a communication network (see, for example, column 3 lines 28-48), comprising:

maintaining a service relationship with the client if the ticket is positively acknowledged by the client (see, for example, column 7 lines 4-63), but Nelson does not explicitly disclose a method comprising, receiving a request for the service from a client, the service request containing a reference to a billing device, generating a ticket for the service, the ticket containing information relating to a client charge that is due prior to or during the use of

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service, sending the ticket to the billing device, and receiving from the billing device a message indicating if the ticket has been acknowledged by the client.

However, Gonthier discloses a method comprising:

receiving a request for the service from a client, the service request containing a reference to a billing device (see, for example, paragraph [0010] - [0014]);

generating a ticket for the service, the ticket containing information relating to a client charge that is due prior to or during the use of service (see, for example, paragraph [0010] - [0014]);

sending the ticket to the billing device (see, for example, paragraph [0010] - [0014]);

receiving from the billing device a message indicating if the ticket has been acknowledged by the client (see, for example, paragraph [0010] - [0014]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to use an application server for charging for a service in a communication network comprising, receiving a request for the service from a client, the service request containing a reference to a billing device, generating a ticket for the service, the ticket containing information relating to a client charge that is due prior to or during the use of service, sending the ticket to the billing device, and receiving from the billing device a message indicating if the ticket has been acknowledged by the client, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

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With respect to **claim 29**, Nelson discloses a method, further comprising terminating the service relationship with the client if the ticket is negatively acknowledged (see, for example, column 7 lines 4-63).

With respect to **claim 30**, Nelson discloses a method, further comprising terminating the service relationship with the client if the message indicates the client has not acknowledged the ticket (see, for example, column 7 lines 4-63).

With respect to **claim 31**, Nelson discloses a method, further comprising terminating the service relationship with the client if the application server does not receive message from the billing device (see, for example, column 7 lines 4-63).

With respect to **claim 32**, Nelson discloses a method, further comprising:
receiving from the billing device an indication of insufficient funds for a client that is a prepaid user (see, for example, column 7 lines 4-63); and
terminating the service relationship with the client in response to receiving the indication of insufficient funds (see, for example, column 7 lines 4-63).

With respect to **claim 33**, Nelson discloses a method for a client in order to be charged for a service in a communication network (see, for example, column 3 lines 28-48), comprising:
responding to the confirmation request (see, for example, column 6 lines 53-57), but
Nelson does not explicitly disclose a method comprising, requesting a service from a service brokering device, receiving a reference for the service requested from the service brokering device, establishing a service relationship between the client and an application server using the reference, and receiving a confirmation request from a billing device concerning charges due for the service.

However, Gonthier discloses a method comprising:

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requesting a service from a service brokering device (see, for example, paragraph [0010]- [0014]);

receiving a reference for the service requested from the service brokering device (see, for example, paragraph [0010]- [0014]);

establishing a service relationship between the client and an application server using the reference (see, for example, paragraph [0010]- [0014]);

receiving a confirmation request from a billing device concerning charges due for the service (see, for example, paragraph [0010]- [0014]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to charge for a service in a communication network comprising, requesting a service from a service brokering device, receiving a reference for the service requested from the service brokering device, establishing a service relationship between the client and an application server using the reference, and receiving a confirmation request from a billing device concerning charges due for the service, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claim 34**, Nelson discloses a method, further comprising displaying the charges to an end user (see, for example, column 3 lines 49-56).

With respect to **claim 35**, Nelson discloses a method, wherein the display is in real time (see, for example, column 3 lines 49-56).

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With respect to **claim 36**, Nelson discloses a method, wherein a plurality of confirmation requests are received and the charges are cumulated, the cumulated charges are displayed to the end user (see, for example, column 3 lines 49-67).

With respect to **claim 37**, Nelson discloses a method for billing for a service in a communication network (see, for example, column 3 lines 28-48), comprising:

responding to the client request by the brokering device with the billing reference and a billing device reference (see, for example, column 6 lines 53-57);

establishing a service relationship between the client and a server for the server by using the billing and billing device references (see, for example, column 7 lines 4-63); and

recording the charges by the billing device if response to the confirmation response (see, for example, column 3 lines 28-48), but Nelson does not explicitly disclose a method comprising, requesting a service from the service brokering device by a client, authenticating the client via the service brokering device, generating a billing reference for the service request by a billing device, producing a ticket by the server concerning charges for the service, sending a confirmation request concerning the charges to the client by the billing device, and receiving a confirmation response from the client.

However, Gonthier disclose a method comprising:

requesting a service from the service brokering device by a client (see, for example, paragraph [0010]- [0014]);

authenticating the client via the service brokering device (see, for example, paragraph [0010]- [0014]);

generating a billing reference for the service request by a billing device (see, for example, paragraph [0010]- [0014]);

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producing a ticket by the server concerning charges for the service (see, for example, paragraph [0010]- [0014]);

sending a confirmation request concerning the charges to the client by the billing device (see, for example, paragraph [0010]- [0014]);

receiving a confirmation response from the client (see, for example, paragraph [0010]- [0014]).

Therefore, it would have been obvious to one of ordinary skills in the art, at the time of invention to have modified the method of Nelson, in accordance with the teachings of Gonthier, in order to bill for a service in a communication network comprising, requesting a service from the service brokering device by a client, authenticating the client via the service brokering device, generating a billing reference for the service request by a billing device, producing a ticket by the server concerning charges for the service, sending a confirmation request concerning the charges to the client by the billing device, and receiving a confirmation response from the client, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

With respect to **claim 38**, Nelson discloses a method, further comprising:

sending information in the confirmation request to the application server (see, for example, column 7 lines 4-63); and

maintaining the service relationship by the application server if the confirmation response positively confirms the charges (see, for example, column 7 lines 4-63).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD R. ULLAH MASUD whose telephone number is (571)270-5390. The examiner can normally be reached on MONDAY TO THURSDAY 9.00 AM TO 5.30 PM (EASTERN TIME).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW S. GART can be reached on (571)272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. U./
Examiner, Art Unit 3687

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit
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